

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte JOHN J. WILLE

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Appeal No. 2001-0983  
Application No. 08/954,946

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ON BRIEF

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Before WINTERS, SCHEINER, and GRIMES, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

VACATUR AND REMAND

For the reasons explained herein, this application is not in condition for a decision on appeal. Therefore, we vacate the examiner's rejection and remand to the examiner for appropriate action.

1. Claim construction

The examiner has not provided a claim construction analysis on the record. Claims must be construed before the claimed invention can be compared to the prior art. See Key Pharms. Inc. v. Hercon Labs. Corp., 161 F.3d 709, 714, 48 USPQ2d 1911, 1915 (Fed. Cir. 1998) (“[N]ot unlike a determination of infringement, a determination of anticipation, as well as obviousness, involves

two steps. First is construing the claim, . . . followed by, in the case of anticipation or obviousness, a comparison of the construed claim to the prior art.”). In some cases, of course, the scope and meaning of the claims are clear enough that examination can proceed without expressly construing the claim language. Such is not the case here.

It is unclear from the claim language what components, if any, other than “phenoxyacetic acid [or a] lower alkyl ester[] thereof,” are required to be present in the composition of claim 18. Ordinarily, a composition for pharmaceutical use (as the composition of claim 18 appears to be) would comprise at least an active ingredient and a pharmaceutically acceptable carrier. Here, however, it is clear that a pharmaceutically acceptable carrier is not required in the composition of claim 18, because that limitation is added by dependent claim 20. If claim 18 were read to require a pharmaceutically acceptable carrier, claim 20 would be entirely superfluous. Such a claim construction is “presumptively unreasonable.” See Beachcombers, Int’l Inc. v. Wildewood Creative Prods., Inc., 31 F.3d 1154, 1162, 31 USPQ2d 1653, 1659 (Fed. Cir. 1994) (claim construction that renders dependent claim superfluous is “presumptively unreasonable.”).

Of course, claim 18 may be drafted so that the claimed composition need not include any components other than “phenoxyacetic acid [or a] lower alkyl ester[] thereof.” If this is the case, it is unclear what the claim requires by reciting that the phenoxyacetic acid is present in “an amount . . . sufficient to prevent said adverse reaction.” That is, if the only required ingredient in the claimed

composition is phenoxyacetic acid, the claim would appear to read on purified phenoxyacetic acid itself, since a pure sample of the compound would “comprise” whatever amount of the compound is considered to be an effective amount.

On the other hand, the specification suggests that the claimed compositions comprise phenoxyacetic acid in a particular range of concentrations. See page 21, lines 3-12 (“[T]he amount of the present agents delivered from a gel formulation . . . is from 0.1 to 10% by weight, and preferably from 0.25% to 2.0% by weight. . . . For example for topical application, the amount of phenoxyacetic acid and lower alkyl esters thereof is from about 0.1 to 2.0 percent by weight, preferably from about 0.25 to 1.0 percent by weight based on the total weight of the composition.”). Since the recited concentration range has an upper boundary, the specification suggests that the claimed composition is intended to comprise components other than phenoxyacetic acid.

Thus, we find that the scope of the claims is unclear. Specifically, it is unclear whether or not it would be reasonable to construe claim 18 to read on phenoxyacetic acid itself. If the claim does not read on phenoxyacetic acid itself, it is unclear what else is required by the claim language.

Keeping in mind the above discussion, the examiner should provide on the record a proper interpretation of the claim language. The examiner should also keep in mind that “in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the

specification.” In re Sneed, 710 F.2d 1544,1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

## 2. The rejection of record

The examiner rejected claims 18-20 as obvious over the Merck Index, based on the following reasoning, quoted in its entirety:

Claim 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Merck Index.

The Merck Index teaches the use of the claimed compound, phenoxyacetic acid in a pharmaceutical formulation with fungicidal activity. The above reference makes clear that the claimed composition is old and well known. To use an old composition for a new purpose does not create a patentably distinct composition. Applicant has presented no evidence to establish the unexpected or unobvious nature of the claimed composition, and as such, claims 18-20 are properly rejected under 35 U.S.C. 103.

Examiner’s Answer, pages 2-3.

The examiner’s explanation of this rejection does not permit meaningful review on our part. First, it is unclear what claim construction the examiner is applying. At one point, the examiner refers to the “claimed compound, phenoxyacetic acid,” but at another point refers to the “claimed composition.” Thus, it is unclear whether the claims are rejected as reading on the purified phenoxyacetic acid disclosed by the Merck Index, or rather are rejected over the fungicidal composition alluded to therein.

Second, a rejection under 35 U.S.C. § 103 presupposes some difference between what is disclosed in the prior art and what is claimed; if there is no difference, the rejection should be for anticipation under 35 U.S.C. § 102. Here,

the examiner has rejected the claims under § 103, but has identified no difference(s) between the prior art compound/composition and the claimed composition. Nor has the examiner explained why, assuming there is some difference, it would have been obvious to change the known composition to the claimed composition.

If the rejection is actually based on anticipation, the examiner needs to discuss the limitations of the claims and explain how those limitations are met, expressly or inherently, in the compound and/or composition disclosed in the prior art. We note that although the Merck Index entry for phenoxyacetic acid states that the compound is a “fungicide,” there is nothing in the entry stating that it is used in pharmaceutical formulations as opposed to, e.g., an agricultural formulation. We also note that phenoxyacetic acid is disclosed to be useful as a “keratin exfoliative,” which would seem more relevant to the instant claims, directed to a composition “for preventing an adverse reaction of the skin.”

### 3. The prior art

The reference applied by the examiner was submitted by Appellant in an Information Disclosure Statement (Paper No. 2, filed December 11, 1997). The administrative file contains no entries in the areas marked “Searched” and “Search Notes,” nor has the examiner cited any references on a Form PTO-892 in either of the Office actions. Thus, the application contains no indication that the examiner has conducted any search of the prior art to determine whether more relevant prior art exists.

Searching the prior art is an integral part of the examination process. See MPEP §§ 704.01 (“After reading the specification and claims, the examiner searches the prior art.”); 904 (“The examiner, after having obtained a thorough understanding of the invention disclosed and claimed in the nonprovisional application, then searches the prior art as disclosed in patents and other published documents, i.e., nonpatent literature.”); and 904.02 (“A proper field of search normally includes the subclass in which the claimed subject matter of an application would be properly classified.”). The field of search must be recorded to ensure a complete administrative record. See MPEP § 719.05:

In the first action on the merits of an application, the examiner shall make an initial endorsement in black ink, in the space provided on the right outside panel of the file wrapper, of the classes and subclasses of domestic and foreign patents, abstract collections, and publications in which the search for prior art was made. . . .

In order to provide a complete, accurate, and uniform record of what has been searched and considered by the examiner for each application, the U.S. Patent and Trademark Office has established procedures for recording search data in the application file. Such a record is of importance to anyone evaluating the strength and validity of a patent, particularly if the patent is involved in litigation.

Upon return of this application, the examiner should conduct a thorough search of the patent and nonpatent literature to determine whether there are prior art references that are more germane than the Merck Index to the patentability of the pending claims.

Summary

This application is not in condition for a decision on appeal. We therefore vacate the examiner's rejection and remand the application to the examiner for action consistent with this opinion.

VACATED AND REMANDED

SHERMAN D. WINTERS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
TONI R. SCHEINER	)	
Administrative Patent Judge	)	APPEALS AND
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	)	INTERFERENCES
	)	
ERIC GRIMES	)	
Administrative Patent Judge	)	

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BRISTOL-MYERS SQUIBB COMPANY  
100 HEADQUARTERS PARK DRIVE  
SKILLMAN, NJ 08558

EG/jlb